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EXAMINER

FISCHER, ANDREW J

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/452,135

Applicant(s)

Jun Fujimoto

Examiner  
Andrew J. Fischer

Art Unit  
3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Dec 23, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 28-41 and 43-55 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 28-41 and 43-55 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on Dec 1, 1999 is/are a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on Dec 23, 2002 is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)

5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Acknowledgments***

1. The amendment filed December 23, 2001 (Paper No. 20) is acknowledged. Accordingly, claims 28-41 and 24-55 remain pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination (“RCE”) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (Paper No. 19). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. The drawings are replete with these errors. Some examples follow. Applicant is reminded no new matter is allowed. The following examples must therefore be shown or the features canceled from the claims:

- a. The “recording in the purchaser rewritable medium the purchase information” as recited in claim 29.
- b. The “registering in the data providing system the third data” as recited in claim 29.

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c. The “recording in the purchaser rewritable record medium the accounting information” as recited in claim 29.

4. The Examiner notes *the claims are replete with the above drawing errors*. All method steps recited in claim 29-41 and 43-55 are clearly not shown in the figures. The Examiner highly recommends Applicant review all pending claims to ensure that every method step recited is shown in the drawings. To show no new matter is found in the drawings, the Examiner respectfully requests Applicants to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The proposed drawing correction to Figure 8 filed on December 23, 2002 (Paper No. 21) has been approved by the Examiner. A proper drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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7. Claims 28-41 and 43-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. See MPEP §2173.05(p) II or *Ex Parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter., 1990). Applicant is claiming a method in claim 28 and a system in claim 42 since claim 42 recites in part, “wherein said data providing system comprises . . .”

Claim 28 is clearly directed towards a the statutory class of a process.<sup>1</sup> To overcome this rejection, Applicant is requested to expressly state which of the four statutory classes he intends his claims to be based upon.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

9. Claims 28-41 and 43-55 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The claims are still replete with errors. Some examples follow:

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<sup>1</sup> See 35 U.S.C. § 101 (1994) (“Whoever invents or discovers any new and useful process . . . may obtain a patent therefor.”); and 35 U.S.C. § 100(b) (1994) (“The term ‘process’ means process, art or method . . .”).

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a. Claims 28-41 and 43-55 are directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention. It is therefore unclear whether Applicant(s) are claiming a process or a machine. See MPEP §2173.05(p) II, *Ex Parte Lyell*, 17 USPQ2d 1548 (B.P.A.I., 1990), and the §101 rejections above.

b. In claim 28, Applicant recites “performing an accounting operation for providing the purchaser with the first data when the third data which is retrieved, is matched . . . .” What is matched? Is it the first data or something else? The phrase appears to intend the third data is matched but this is incorrect because the third data would be matched to itself which would always be a match. “A claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983). Moreover, “semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).

Moreover, “third data” is “third data.” Its not “third data” in one part of the claim and a different “third data” in another part of the claim since “the same word[s] appearing in the same claim should be interpreted consistently.” *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1345, 47 USPQ2d 1418, 1425 (Fed. Cir. 1998).

c. Also in claim 28, the phrase “for representing the purchase information of the first data” is unclear since its not known as to what this dependent clause modifies. The rules of English grammar state that it should modify its antecedent “the third data.”

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d. In claims 29 and 30, the scope of the claims is unclear since claim 29 fails to further limit claim. See the rejection under 35 U.S.C. 112, forth paragraph below.

e. In claim 31, the phrase “for which the accounting operation is finished” does not make sense.

10. Claims 29 and 30 are rejected under 35 U.S.C. 112, forth paragraph, as failing to further limit since the dependent claim changes the scope of the dependent claim 29 from that of which it depends (i.e. claim 28). See MPEP §608.01(n) III. Applicant states that the step in claim 29 (the “recording . . . the fist data and the third data) *comprises* “recording in the purchaser rewritable medium the purchase information which includes an accounting information representing the accounting operation . . . .” Claim 29 could therefore be infringed without infringing claim 28 since claim 29 no longer requires “recording . . . the first data and the third data.” The claims are *replete* with these types of errors.

#### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the Applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the Applicant for patent.

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12. Claims 28-41 and 43-55, ***AS UNDERSTOOD BY THE EXAMINER***, are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et. al. (U.S. 6,129,274) ("Suzuki"). Suzuki discloses the following: retrieving said third data of said purchaser (Item decryption, quantity, and price); the third data is registered for every purchaser (every purchaser using the card for a transaction has an item decryption, quantity, and price); the third data is based on second data (second data is customer name, address, ect; the items purchased are based upon the person doing the purchasing); a purchase request is made by a purchaser (who else would make a purchase request?); performing an accounting operation (totaling the items purchased or noting which particular item is purchased); the third data is matched (the POS and the card 10 will have matching information, both will have item description, quantity, and price); first, second, and third data is recorded on card 10 after the after the information is received; the smart card must be registered (it must work with the POS system); purchase information includes data specific information (unless the information is a copy, its always data specific); and including recording price information (inherent).

13. Functional recitation(s) using the word "for" (e.g. "for providing a purchaser with a first data such that . . . said first data can be recorded" as recited in claim 28) have been given little patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a

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purpose and intended result, the expression doe not result in a manipulative difference in the steps of the claim.).

14. The Examiner notes that Applicant frequently recites conditional phrases throughout the claims (e.g. “can be” as recited in claim 28, line 8; and “when the accounting operation is finished” as also recited in claim 28). This language makes optional the phrases upon which they depend since the dependent phrase will only occur if the accounting operation is finished. “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

[Emphasis in original.]” MPEP §2106 II C.

15. For clarity and due process purposes, the Examiner again notes that Applicant has declined the Examiner’s express invitation<sup>2</sup> to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustom meanings. As noted in the previous Office Action on the merits,<sup>3</sup> the presumption in favor of the ordinary and accustom meaning is confirmed. Accordingly, the claims continue to be interpreted with their “broadest reasonable interpretation,” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997),<sup>4</sup> and the Examiner continues to rely heavily and extensively on this interpretation.<sup>5</sup>

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<sup>2</sup> See the Office Action mailed December 6, 2001, Paper No. 10, Paragraph No. 11.

<sup>3</sup> See the previous Office Action on the merits mailed June 21, 2002, Paper No. 15, Paragraph No. 11.

<sup>4</sup> See also MPEP §2111 and §2111.01; *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en

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See e.g. *Transclean Corp. v. Bridgewood Servs., Inc.*, 290 F.3d 1364, 1381, 62 USPQ2d 1865, 1877 (Fed. Cir. 2002) (“Because the patentee has not chosen to be his own lexicographer in this instance, [the claimed element] should carry its ordinary meaning . . .”) (Clevenger, J. dissenting in part). Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles apply to all examined claims currently pending.

16. Because the statutory class of the claimed subject matter is in doubt, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex I*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed the claims and it is the Examiner’s position that the claims *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicant disagrees with the Examiner, the Examiner respectfully requests Applicant in his next response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and

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banc).

<sup>5</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . [Emphasis added.]”

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treated accordingly. Applicant is reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).<sup>6</sup> Failure by Applicant in his next response to also address this issue or to be non-responsive to this issue entirely will be considered intent by Applicant *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

***Claim Rejections - 35 USC § 103***

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 28-41 and 43-55, ***AS UNDERSTOOD BY THE EXAMINER***, are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki.<sup>7</sup> It is the Examiner’s principle position that the claimed methods are inherently disclosed. However, if not inherent, the missing elements in Suzuki are only found in the nonfunctional descriptive material and are not

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<sup>6</sup> See also MPEP §2113.

<sup>7</sup> See MPEP §2112 expressly authorizing alternative 102/103 rejections when the question of inherency is present in the §102 rejection.

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functionally involved in the steps claimed (i.e. the steps of “recording price information” as recited in claim 39 is in no way dependent upon the content of the information recorded).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the content of Suzuki with any type of content. The descriptive material will not distinguish the claimed invention over the prior art in terms of patentability because the data does not functionally relate to the steps in the method. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowery*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).<sup>8</sup>

### ***Response to Arguments***

19. Regarding the drawings, the previous Office Action on the merits (Paper No. 15) stated in Paragraph No. 3:

The Examiner notes the claims are replete with the above drawing errors. In fact, the application contains only one flow chart (Figure 7). All method steps recited in claim 28-55 are clearly not shown in figure 7. The Examiner highly recommends Applicant review all 28-55 claims to ensure that every method step recited is shown in the drawings. To show no new matter is found in the drawings, the Examiner respectfully requests Applicants to explicitly show where in the specification Applicant has support or antecedent basis for any new drawings or drawing changes. Additionally, a proposed drawing correction or corrected drawings are required in reply to this Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

20. Applicant has provided a single drawing (Figure 8) which is approved by the Examiner. The proposed drawing appears to recite the claimed features in claim 28 only. What about the

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<sup>8</sup> See also MPEP §2106 IV B.

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method steps (if its a method or process that Applicant is intending to claim) recited in claims 29-41 and 43-55, where are they shown in the drawings? The Examiner has attempted to make this clear to Applicants and stated in the paragraph quoted above that *the drawings do not show all claimed features*. In fact, the Examiner expressly stated in the paragraph above, “The Examiner highly recommends Applicant review all 28-55 claims to ensure that every method step recited is shown in the drawings.” The Examiner does not know how to more clearly state his position and is perplexed at Applicant’s response. It appears (by Applicant’s choice) that the prosecution of this application will continue cyclicly with the Examiner pointing out three drawing errors and the Applicant correcting the three drawing errors. Nevertheless, Applicant being the master of his application is free to do as he so chooses.

21. Furthermore, Applicant would discover many of the 35 U.S.C. § 112 errors discussed by the Examiner if Applicant attempted a flow chart of his claimed invention. It is no coincidence that applicants with countless drawings errors usually have countless 35 U.S.C. § 112 errors as well.

22. In claim 28, it still appears applicant is intended to claim a hybrid claim (i.e. a combination product and process). The Examiner respectfully requests Applicant to expressly state on the record which of the four statutory classes<sup>9</sup> his claimed invention is attempting to fall under.

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<sup>9</sup> 35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define “things” (or products) while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed).

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23. Regarding the allowable subject matter, the Examiner stated in the previous Office Action on the merits (Paper No. 15, Paragraph No. 15):

*For purposes of appeal only*, claims 42-55 are considered allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

It is the Examiner position that the claims are so unclear and have so many §112 2<sup>nd</sup> paragraph and other rejections (i.e. it not known whether Applicant is claiming a method or a system) that ascertaining what is the claimed subject matter can not be made at this time. Once the §112 2nd paragraph and other rejections are corrected, *the claims will then be reevaluated in light of the prior art* so as to ascertain their patentability. See MPEP §2173.06. [Emphasis added.]

24. Applicant states “he greatly appreciates the Examiner’s indication that claims 42-55 are

allowable . . .” Apparently Applicant failed to read or understand the above paragraphs.

Because the claims *remain replete with 35 U.S.C. § 112 errors* and because Applicant either chooses to ignore express statements made by the Examiner (e.g. “Once the §112 2nd paragraph and other rejections are corrected, the claims will then be reevaluated in light of the prior art so as to ascertain their patentability”) or fails to read the Examiner’s statements outright, confusion in the allowability of the claims has resulted. So that Applicant is in no way confused, all claims are now rejected, as best understood by the Examiner, on prior art.

### *Conclusion*

25. All MPEP sections cited within are from the Manual of Patent Examining Procedure (MPEP) Eighth Edition, August 2001 unless expressly noted otherwise.

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26. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicant with notice—for due process purposes—of his positions regarding his factual determinations and legal conclusions. If Applicant still disagrees with *any* factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>10</sup> the Examiner respectfully requests Applicant *in his next response* to expressly traverse the Examiner's position and provide appropriate arguments in support thereof. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner's positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292.

*AFischer 3/9/03*  
ANDREW J. FISCHER  
PATENT EXAMINER

AJF  
March 9, 2003

*Rena Dye 3/10/03*  
RENA DYE  
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<sup>10</sup> E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.